

## **REMARKS**

In view of the above amendments and following remarks favorable reconsideration is respectfully requested.

The claims are 1-2 and 5-9.

The Examiner states on page 2 of the Office Action that the USPTO has not received a certified copy of the priority document (JP 2004-007030) for the present application. Applicants note that PCT/IB/304 indicates that WIPO has received the priority document. Therefore, Applicants respectfully request the USPTO to obtain the priority document from WIPO.

Claim 1 is currently amended. New claims 7-9 are added. Claims 3 and 4 are canceled.

Support for the “cationic epoxy resin” and “a blocked isocyanate curing agent” amendments to claim 1 may be found, for example, in original claim 3 (now cancelled).

Support for the “optional pigment” amendment to claim 1 may be found in paragraph [0031] of the specification.

Support for the concentration of pigment amendment to claim 1 may be found in original claim 4.

Support for the amendment to the resin fine particle average particle size and amount can be found in paragraphs [0023] and [0028] of the specification.

Support for new claims 7 and 8 can be found in paragraphs [0031] and [0056] of the specification.

Support for new claim 9 can be found in paragraphs [0071], [0018], [0028], and [0103]-[0107], and original claims 1 and 3-5 of the specification.

The amendments to claims 5 and 6 are editorial and self-explanatory.

Accordingly no new matter is added and entry of this amendment is respectfully requested.

### **Prior Art Rejections**

Claims 1, 2, and 4-6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Retzlaff et al. (US 2003/0150729). Claims 1 and 3 are rejected under 35 U.S.C. § 102(b) as

being anticipated by Hunakoshi et al. (US Patent No. 6,054,033). Claims 1 and 3 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 6 of Hunakoshi et al.

Applicants respectfully traverse each of these rejections.

1. *Retzlaff et al.*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 to USPQ 2d 1051, 1053 (Fed. Cir. 1987). Retzlaff does not expressly or inherently disclose the average particle size or solid contents of the coating composition recited in claim 1.

Retzlaff et al. discloses electrocoating compositions containing solid particles. Retzlaff et al. also discloses cationic electrocoating compositions, and anionic electrocoating compositions. See claims 9, 45, etc.

However, Retzlaff et al. does not disclose the cationic electrodeposition coating compositions of claim 1 as currently amended. The working examples of Retzlaff et al. are shown in the attached Exhibit 1, Table A. As shown in Exhibit 1, Retzlaff et al. does not disclose a composition which corresponds to claim 1, as currently amended, of the present application. In particular, Retzlaff et al. does not disclose or suggest resin fine particles the recited average particle size of 1-8 $\mu$ m and solid contents of resin fine particles being in a proportion of 3-15% by weight.

Furthermore, Retzlaff et al. does not disclose or suggest a composition that improves the “cissing-preventing property” of an electrodeposition coating composition. See e.g., paragraphs [0018], [0028] and [0103]-[0107] of the present specification. In contrast to the compositions of Retzlaff et al., the electrodeposition coating compositions of the present invention have good oil contaminated cissing-preventing properties. This is primarily due to the claimed resin fine particles having an average particle size of 1-8 $\mu$ m and being in a proportion of 3-15% by weight based on the solid contents of the coating composition.

In this regard, Retzlaff et al. also clearly does not disclose or suggest the invention of new

claim 9 directed to a method of improving cissing-preventing properties in electrocoating.

Accordingly, the rejection over Retzlaff et al. must be withdrawn.

## *2. Hunakoshi et al.*

Hunakoshi et al. also does not expressly or inherently disclose cationic electrodeposition coating compositions with resin fine particles having an average particle size of 1-8  $\mu\text{m}$ .

Hunakoshi et al. discloses cathodic electrodeposition paint compositions which contain resin fine particles having a particle size of less than 1  $\mu\text{m}$ . The resin particles of Hunakoshi et al. are therefore smaller than the resin particles of the present claims. Hunakoshi et al. discloses a number of working examples of resin particles. See production examples 8 and 9. The particle sizes of the resin particles is 78 nm (column 8, line 16) and 120 nm (column 9, line 30). Therefore the particle sizes disclosed by Hunakoshi et al. are not within the range of 1-8  $\mu\text{m}$  presently claimed. Accordingly, the rejection over Hunakoshi et al. must be withdrawn.

In summary, the cationic electrodeposition coating deposition composition of claim 1 as currently amended is not disclosed or suggested by Retzlaff et al. or Hunakoshi et al.

Furthermore, the cited art does not suggest the “cissing-preventing property” of the present invention. As mentioned, the good oil contaminated cissing-preventing property of the present invention is due to the recited resin fine particles having an average particle size of 1-8  $\mu\text{m}$  and being in a proportion of 3-15% by weight based on the solids content of the coating composition. The present invention can therefore also not be arrived at by combining Retzlaff et al. and Hunakoshi et al.

Accordingly, Applicants submit that the pending prior art rejections must be withdrawn and the application allowed.

## Conclusion

No further issues remaining, allowance of this application is respectfully requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned by telephone to resolve such issues.

Respectfully submitted,

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Attachment: Exhibit 1